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OCT 22 2008

In re Application of :
Harraway :
Application No. 10/053,920 : DECISION ON PETITION
Filed: January 24, 2002 :
Attorney Docket No. N/A :
For: PORTABLE DIALYSIS MACHINE :

This is a decision on the petition under the unavoidable standard of 37 CFR 1.137(a), filed September 2, 2008 (certificate of mailing date August 27, 2008), to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to timely reply to a non-final Office action, mailed July 31, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on November 1, 2003. A Notice of Abandonment was mailed on June 1, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition lacks item (3).

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner argues that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. Petitioner asserts incapacitation as the cause of unavoidable delay. A showing of “unavoidable” delay based upon incapacitation must establish that petitioner’s incapacitation was of such nature and degree as to render petitioner unable to conduct business (e.g., correspond with the Office) during the period between October 31, 2003 and August 27, 2008. Such a showing must be supported by a statement from petitioner’s treating physician, and such statement must provide the nature and degree of petitioner’s incapacitation during this above-mentioned period.

The statement by Dr. Mahendra establishes that Mr. Harraway was diagnosed with Traumatic Stroke Injury from January 31, 2004. In February 2005, he had some heart surgery. In June of 2007, he was diagnosed with a number of conditions and underwent surgery. Afterwards, he suffered a stroke and further kidney problems and is undergoing rehabilitation.

While the Office is not unsympathetic to petitioner’s health problems, it must be established that petitioner was unable to conduct business from October 31, 2003 to August 2008. The above-listed medical events do not cover the entire period of delay. For example, Dr. Mahendra’s statement is evidence that January 31, 2004 was the beginning of petitioner’s health problems. The due date for the Office action was October 31, 2003. The reason for three months worth of delay has not been explained by a healthcare provider. In addition, Dr. Mahendra states that in February 2005 petitioner had some heart surgery. The next medical event took place in June of 2007. Why didn’t petitioner attend to his patent business during the **over two year period** between medical events?

Petitioner should note that under the circumstances of this case, he will have to provide ***documents from licensed health care providers, demonstrating the nature and extent of petitioner's incapacitation***, in such a manner that petitioner was, until the filing of the petition on August 27, 2008, prevented from taking any earlier action with respect to this patent application.

Additionally, petitioner must state how he managed to conduct his daily personal and business affairs, including scheduling and settlement of short and long term debts and business obligations, bills, rent or mortgage payments, income taxes etc., during the time in question – from October 31, 2003 to August 25, 2008. Did petitioner fail to take care of other business during the time period in question? Please be specific in response and provide statements from a persons who assisted petitioner. Petitioner must demonstrate that his health problems were so severe as to cause the deadline for responding to the Office action to have been unavoidably missed.

While petitioner asserts incapacitation as the sole cause of delay, it is noted that the July 31, 20203 non-final Office action was properly mailed to the then-correspondence address of record, which was:

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19900 BEACH BLVD., SUITE C-2
HUNTING BEACH CA 92648

Unfortunately, it appears that applicant's attorney did not respond to the Office action. The Office has no record of receiving a timely reply.

Because petitioner was **and currently is still represented by a registered practitioner** (at least according to Office records), the Office must rely on the actions or inactions of the duly authorized and voluntarily chosen representative of the applicant, and the applicant is bound by the consequences of those actions or inactions. *Link v. Wabash*, 370 U.S. 626, 633-34 (1962). If the attorney made any errors, petitioners are bound by such errors.¹

An attorney must act reasonably and prudently.

If [the] attorney somehow breach[es] his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to

¹ See *California Med. Products v. Technol Med. Products*, 921 F. Supp. 1219, 1259 (D. Del. 1995) (citing *Smith v. Diamond*, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981) (citing *Link v. Walbash Railroad Co.*, 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962))).

overlook [the attorney's] action or inaction with regard to the patent application. He hired the [attorney] to represent him. [The attorney's] actions must be imputed to him.²

Petitioner is advised that delay resulting from a failure in communication between a client and a registered practitioner is not unavoidable delay. In Re Kim, 12 U.S.P.Q.2d 1595 (Comm'r Pat. 1988).

The record indicates that Mr. Beech was responsible for prosecution of the application when the reply necessary to avoid abandonment was due. Therefore, petitioner must provide a statement from Mr. Beech explaining why action was not timely taken to prevent the application from becoming abandoned.

The USPTO is requesting that Mr. Beech provide a statement explaining why appropriate action was not timely taken to prevent the application from becoming abandoned. What was the agreement between Mr. Beech and applicant regarding representation?

Petitioner has appointed a representative to conduct all business before the U.S. Patent and Trademark Office (Office). The Office will not engage in dual correspondence with petitioner and petitioner's representative. Accordingly, petitioner must conduct all future correspondence with this Office through the representative of record. If petitioner no longer wishes to be represented by the representative of record, then a revocation of the power of attorney or patent agent should be submitted. A correspondence address must be included on the correspondence instructing the Office where all future communications are to be mailed. *See* 37 CFR 1.33(a). A courtesy copy of this decision will be mailed to the address listed on the petition. It is noted that only a partial address was listed on the petition. The undersigned conducted an Internet search to ascertain a complete address for Mr. Harraway.

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the

² Haines v. Quigg, 673 F. Supp. 314, 317, 5 U.S.P.Q. 2d (BNA) 1130 (citing Link v. Walbash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962)) ("Petitioner voluntarily chose his attorney as his representative in the action and he cannot now avoid the consequences of the acts or omissions of this freely selected agent ... Each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'" (emphasis added); Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983) ("Courts hesitate to punish a client for its lawyers gross negligence, especially when the lawyer affirmatively misled the client" but "if the client freely chooses counsel, it should be bound to counsel's actions."); *see also* Wei v. State of Hawaii, 763 F. 2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983)). *See also* Smith v. Diamond, 209 U.S.P.Q. (BNA) 1091 (D. D.C. 1981).

application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

The petition under 37 CFR 1.137(a) is dismissed.

Petitioner may wish to consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an “unintentionally” abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was “unavoidable.” This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b).

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

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Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By facsimile: **(571) 273-8300**
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

A handwritten signature in cursive script, reading "Shirene Willis Brantley".

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

CC: JAMES D. HARRAWAY
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